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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/691,900	08/01/96	APTE	J 2-4

EXAMINER	
ROMAIN, J	
ART UNIT	**PAPER NUMBER**
2765	9

LM01/0609

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DATE MAILED: 06/09/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/691,900	Applicant(s) Apte et al.
	Examiner Romain Jeanty	Group Art Unit 2765

☒ Responsive to communication(s) filed on *Mar 26, 1999*.

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *three* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-36, 41, 42, 45, 47-61, 63, and 64* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) *1-36, 41, and 42* is/are allowed.

☒ Claim(s) *45, 47-52, 54-61, 63, and 64* is/are rejected.

☒ Claim(s) *53* is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Claim Objections

1. Claim 48 is objected to because of the following informalities:

As per claim 48, the Examiner suggests adding "to" after adapted.

Claim Rejections - 35 U.S.C. § 112

2. Claims 61,63-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 61, 63-64, it is not clear whether a computer, a server, a client , a web site or a user is doing the receiving, selecting, and the sending.

3. Claims 62 and 63 recite the limitation " advertisement" in limitation step b. There is insufficient antecedent basis for this limitation in the claim.

4. Claim 47 recites the limitation "further comprising means for storing an electronic coupon at the request of a user, and means for redeeming the electronic coupon when requested by the user" in page 46, lines 6-9. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 U.S.C. § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 48-52, 54, 57-58 and 60 are rejected under 35 U.S.C 102 (e) as being anticipated over **Judson** (Patent No. 5737619).

As per claim 48, **Judson** discloses a client computer for presenting advertising to a user, comprising:

A microprocessor (figure 2, element 32), a memory (figure 2, element 32) that stores browser software adapted to be executed by retrieve and display a hypertext page from a site and advertisement software adapted to retrieve and display an advertisement from an advertising server, a display device (figure 2, element 24) on which to display the hypertext page and an advertisement to the user (column 7, lines 22-33; column 8, lines 59-66).

As per claim 49, **Judson** discloses an advertisement software is adapted be executed by the microprocessor to display an advertisement that is part of a stream of advertisements (column 7, lines 43-45).

As per claims 50 and 52, it is inherent for the advertisement software to display sale agent and a pause button to the user.

As per claim 51, **Judson** discloses an advertising software adapted to be executed by the microprocessor to display a list of topics to the user, such that when

the user selects a topic from the list of topic, advertisements pertaining to the topic are received from the advertising software (column 7, lines 59-64).

As per claim 54, it is inherent for advertisements to stream from the advertisement server to the client computer.

As per claims 57 and 58, it is inherent that the graphical user interface be displayed by the software.

As per claim 60, **Judson** discloses an advertising software adapted to be executed by the microprocessor to display a home page button, such that when the home page button is selected by the user, a page is displayed to the user by the browser software, wherein the page included information pertaining to the sponsor of the advertisement that was displayed to the user at the time the user selected the home page button (see figure 5).

7. Claims 61 and 63 are rejected under 35 U. S. C 102 (e) as being anticipated by Gerace (Patent No. 5,848,396).

As per claim 61, **Gerace** discloses:

Receiving information about a page that is displayed on the computer by browser software (column 4, lines 1-6; column 3, lines 57-62; column 7, lines 31-34).

Selecting an advertisement based at least partly on the information received about the page displayed on the computer by the software (column 7, lines 13-32; column 14, lines 39-49).

Sending the selected advertisement to the computer (column 4, lines 50-55).

As per claim 63, **Gerace** discloses a method for providing a page to a computer on a network, comprising:

Receiving a request for a page from the computer (column 14, lines 6-10).

Identifying the advertisement that was displayed on the computer at the request was made (column 9, lines 8-15).

Selecting a page based at least partly upon the identified advertisements (column 8, lines 15-21).

Sending the selected page to the computer (column, 4. Lines 50-55; column 10, lines 39-46).

8. Claims 45 and 64 are rejected under 35 U. S. C. 102(e) as being unpatented over **Reilly et al.** (Patent No. 5,740,549).

As per claims 45 and 64, **Reilly et al.** disclose a system for providing advertising to a user through a hypertext network, comprising:

a. Providing advertisements to a subscriber (column 2, lines 28-32).

b. Storing an advertisement and accepting secure purchase data from the user (see the abstract)

c. Loading advertisements and displaying the advertisements to the user (column 15, lines 8-14).

d. Displaying a page to the user (column 6, lines 3-6).

e. Identifying a topic of a page displayed to the user (column 2, lines 48-53).

f. Selecting an advertisement to be displayed to the user based at least partly on the topic of the page displayed to the user (column 2, lines 48-53; column 18, lines 33-37).

As per claim 64, **Reilly et al.** disclose a method for providing advertising to a computer on a network, comprising:

Receiving an advertisement topic selection from the computer (column 2, lines 62-67, continue in column 3, lines 1-11).

Sending to the computer an advertisement related to the topic selection (column 9, lines 25-33).

Claim Rejections - 35 U.S.C. § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 55,56 and 59 are rejected under 35 U. S. C. 103(a) as being unpatentable over **Judson** (Patent No. 5,737,619).

As per claim 55, **Judson** explicitly fails to disclose a media clip button. Examiner takes official notice that using a media clip button would have been obvious to person of ordinary skill in the art in order to allow a user to select a particular product to be purchased.

As per claim 56, **Judson** explicitly fails to disclose a secure purchase button. Examiner takes official notice that using a secure purchase button would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to allow a customer the privilege of making a purchase order.

As per claim 59, **Judson** explicitly fails to disclose an electronic coupon button. Examiner takes official notice that selecting an electronic coupon button is old and well known in the art. It would have been obvious to person of ordinary skill in the art at the time of the applicant's invention to include an electronic coupon button to allow a customer to download redeemable coupons, thereby significantly increasing the value of the on-line informational content provided to the customer.

Allowable Subject Matter

11. Claims 1-36, 41-42 are allowed.

Claim Objections

12. Claim 53 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

13. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from

the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (703) 308-9585.

The examiner can normally be reached on weekdays from 8:00 a.m to 4:30 p.m. If attempts to reach the examiner are not successful, the examiner's supervisor, Allen R. MacDonald, can be reached at (703) 305-9708.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703)308-3900.

Romain Jeanty

May 25, 1999.

ALLEN R. MACDONALD
SUPERVISORY PATENT EXAMINER